

## REMARKS

Claims 1 and 3-44 are pending in the present application. Claims 5 and 26 have been canceled without prejudice, claims 1, 4, 6-9, 23, 25, 27, 29, and 36 have been amended, and no claims have been added, leaving claims 1, 3-4, 6-25, and 27-44 for consideration upon entry of the present Amendment. The claims have been amended as explained below. No new matter has been introduced by these amendments.

Amendments to and cancellation of the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment and cancellation of the claims is not in any manner intended to, and should not be construed to, waive applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration and allowance of the claims is respectfully requested in view of the foregoing amendments and following remarks.

### Claim Amendments

Claims 1, 23, and 36 have been amended to further define the present invention. Support for these amendments can be found at least in the application as filed, page 3, paragraph [0009], page 5, paragraphs [0019]-[0020], and page 8, paragraph [0033].

Claims 4, 6-9, 25, 27, and 29 have been amended to properly depend from and further define claims 1 and 23 in view of the amendments to claims 1 and 23.

No new matter has been introduced by the foregoing amendments.

## Claim Rejections Under 35 U.S.C. § 102(e)

### Mitra

Claims 1 and 3-35 were previously rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Patent No. 6,673,761 to Mitra et al., hereafter “Mitra”. Applicants respectfully traverse this rejection in view of the amendments to claims 1, 4, 6-9, 23, 25, 27, and 29.

Anticipation requires that all of the limitations of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

For a rejection under section 102 to be proper, the cited reference must clearly and unequivocally disclose the claimed subject matter without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *In re Arkley*, 172 USPQ 524, 526 (C.C.P.A. 1972).

Applicants respectfully submit that Mitra does not teach all the elements of independent claims 1, 23, and 36, as amended. For example, nowhere does Mitra teach the presence of a film forming compound in an amount of about 0.1 to about 5 wt.%. A prior Office Action dated 4/23/2007 concedes this wherein the following text is found in the Office Action dated 4/23/2007 “Mitra et al. would meet the ... limitation recited in the instant claims, since it is known in the art that adjunct ingredients, such as polymers, are present in this amount.” (4/23/2007 Office Action, page 6) However, Mitra et al. does not specifically disclose the claimed limitation of 0.1-5% by weight of the film forming compound thus, the Office Action is suggesting that it is known in the art that adjunct ingredients, such as polymers, are present in this amount without specifically giving a reference. That is, the Examiner is alleging that such an amount of 0.1-5% by weight would be obvious over Mitra, and therefore conceding Mitra does not teach this amount explicitly or inherently. Applicants respectfully traverse this suggestion moreover, Mitra cannot be the basis for a 102 rejection as it does not teach or disclose all of the claimed limitations.

Therefore, applicants respectfully assert that claims 1 and 3-35, as amended, are patentable over Mitra under 35 U.S.C. § 102(e) because Mitra does not explicitly or inherently teach all the elements of the present claims. Withdrawal of this rejection is respectfully requested.

#### Ouellette

Claims 1 and 3-35 were previously rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Patent Publication No. 2004/0244132 to Ouellette et al., hereafter “Ouellette”. Applicants respectfully traverse this rejection in view of the amendments to claims 1, 4, 6-9, 23, 25, 27, and 29.

Independent claims 1, 23, and 36 as amended require the presence of water in an amount of about 80 wt.% to about 99 wt.%. Applicants respectfully assert that at least this limitation is not disclosed by Ouellette. Ouellette discloses that water is preferably present at a level of less than 50%, more preferably less than about 10%, and most preferably, less than about 5%. (Ouellette, paragraph [0156]).

For at least the above reason, applicants respectfully assert that Ouellette does not teach all the elements of independent claims 1, 23, and 36 as amended, therefore the present claims are not anticipated by Ouellette. Withdrawal of this rejection is respectfully requested.

#### Shannon

Claims 1 and 3-44 were previously rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Patent Publication No. 2003/0168642 to Shannon, hereafter “Shannon”. Applicants respectfully traverse this rejection in view of the amendments to claims 1, 4, 6-9, 23, 25, 27, 29, and 36.

As amended, independent claims 1 and 23 require the presence of a brake dust barrier composition comprising about 0.1 wt.% to about 5 wt.% of a film forming compound selected from the group consisting of sulfonated polystyrenes, sulfonated styrene/maleic anhydride copolymers, linear silicone/ethylene oxide copolymers,

silicone/acrylate copolymers, and mixtures thereof. Independent claim 36 requires the presence of a brake dust barrier composition present in an amount ranging between about 0.1 wt.% and about 5 wt.% of the cleaning formulation and comprising a sulfonated styrene/maleic anhydride copolymer.

Shannon does not disclose any of the foregoing film forming compounds as recited in amended independent claims 1, 23, and 36. Therefore, applicants respectfully assert that Shannon does not teach all the elements of the foregoing claims.

In view of the above, applicants respectfully assert that the present claims are not anticipated by Shannon because Shannon does not teach all the elements of the present claims as amended. Withdrawal of this rejection is respectfully requested.

#### Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1 and 3-44 were previously rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Mitra. Applicants respectfully traverse this rejection in view of the amendments to claims 1, 4, 6-9, 23, 25, 27, 29, and 36.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Establishing a prima facie case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. *See, e.g.*, MPEP 2143.03; *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

Applicants' independent claims 1, 23, and 36, as amended, require the presence of about 0.1 to about 5 wt.% of a film forming compound selected from the group consisting of sulfonated polystyrenes, sulfonated styrene/maleic anhydride copolymers, linear silicone/ethylene oxide copolymers, silicone/acrylate copolymers, and mixtures thereof in claims 1 and 23, and sulfonated styrene/maleic anhydride copolymers in claim 36.

Nowhere does Mitra teach the presence of a film forming compound in an amount of about 0.1 to about 5 wt.%. A prior Office Action acknowledges the same as discussed above.

However, the prior Office Action asserts that “the adjunct ingredients, such as polymers, taught by Mitra et al would meet the 0.1-5% by weight limitation recited in the instant claims, since it is known in the art that adjunct ingredients, such as polymers, are present in this amount.” (4/23/2007 Office Action, page 6).

Mitra is concerned with a cleaning composition loaded on a cleaning wipe having improved biocidal release from the cleaning wipe. (Mitra, abstract). Cleaning wipes have been used to clean infants, polish and clean furniture, to clean an individual’s hands, counter tops, floors, and the like, glass surfaces, and to disinfect a variety of surfaces. (Mitra, column 1, lines 18-28). The cleaning wipe contains an effective amount of biocide to obtain the desired disinfecting qualities; (Mitra, column 3, line 62, to column 5, line 65); an effective amount of biocide release agent to increase the amount of biocide released from the cleaning wipe on a surface to be disinfected; (Mitra, column 5, line 66, to column 8, line 22); an effective amount of surfactant; (Mitra, column 8, line 24, to column 9, line 39); a builder detergent; (Mitra, column 9, line 40, to column 10, line 50); a solvent; (Mitra, column 10, line 51, to column 12, line 21).

In addition to the foregoing materials, Mitra discloses that the cleaning composition can further contain one or more adjuncts. (Mitra, column 12, lines 22-23). The adjuncts include, but are not limited to, buffering and pH adjusting agents, fragrances or perfumes, waxes, dyes and/or colorants, solubilizing materials, stabilizers, thickeners, defoamers, hydrotropes, lotions and/or mineral oils, enzymes, bleaching agents, cloud point modifiers, preservatives, and/or polymers. (Mitra, column 12, lines 23-29). Mitra then discloses polystyrenesulfonates, among others, in a list of about 130 examples of possible compounds to be used as adjuncts. (Mitra, column 12, line 29, to column 14, line 15). Further, Mitra is silent regarding the suitable amount of adjunct to use.

In addition to the above, Mitra gives no direction, teaching, or suggestion to one with ordinary skill in the art to preferentially select polystyrenesulfonates from among the

myriad of adjuncts and in the amount claimed by applicants. This is further evidenced in Mitra's examples 1-10, none of which disclose the use of a polymer, let alone a polystyrenesulfonate. Therefore, applicants respectfully assert that Mitra would not suggest to or motivate one with ordinary skill in the art to select polystyrenesulfonates from among the myriad of possible adjuncts, and in an amount of about 0.1 to about 5 wt.%. Further, there is no teaching, suggestion, or motivation to one with ordinary skill in the art to modify Mitra to select sulfonated styrene/maleic anhydride copolymers in an amount of 0.1 to about 5 wt.% as recited in applicants' independent claim 36 as amended.

Applicants respectfully submit that such an allegation in view of Mitra can only be arrived at based on improper hindsight, which fails to consider the totality of applicant's invention and to the totality of the cited references. More specifically the Examiner has used applicants' disclosure to select portions of the cited references to allegedly arrive at applicants' invention. In doing so, the Examiner has failed to consider the teachings of the references or applicants' invention as a whole in contravention of section 103.

In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole", not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

"[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution."

*Id.*

In view of the above, applicants respectfully assert that the present claims are patentable over Mitra under 35 U.S.C. § 103(a) because Mitra does not teach or suggest all the elements of independent claims 1, 23, and 36 as amended, and one with ordinary skill in the art would not be motivated by Mitra to modify the same to arrive at

applicants' claims without the use of improper hindsight. Withdrawal of this rejection and allowance of the claims is respectfully requested.

### Ouellette

Claims 1 and 3-44 were previously rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Ouellette. Applicants respectfully traverse this rejection in view of the amendments to claims 1, 4, 6-9, 23, 25, 27, 29, and 36.

Independent claims 1, 23, and 36, as amended, require the presence of about 80 to about 99 wt.% water. Ouellette, on the other hand, teaches the presence of water preferably at a level of less than 50%, more preferably less than about 10%, and most preferably, less than about 5%. (Ouellette, page 12, paragraph [0156]).

Applicants respectfully assert that there would be no motivation for one with ordinary skill in the art to modify Ouellette to arrive at applicants' limitation of about 80 to about 99 wt.% water, not only because Ouellette discloses a substantially lower amount, but also because Ouellette teaches away from increasing the amount of water. For example, Ouellette teaches that the treatment composition preferably melts above 25° C, and more preferably above 35° C. (Ouellette Page 4, Paragraph 72) This suggests to one with ordinary skill in the art that increasing the water amount in Ouellette would adversely affect the melting point, and substantially reduce it, thereby destroying the intent of Ouellette.

In this regard, the courts have held that "[i]f the proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon* 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, applicants respectfully assert that the present claims are patentable over Ouellette because Ouellette does not teach or suggest all the elements of independent claims 1, 23, and 36 as amended, and there would be no motivation to one with ordinary skill in the art to modify Ouellette to arrive at applicants' claims, at least

because by so doing the intent of Ouellette would be destroyed. Withdrawal of this rejection is respectfully requested.

Shannon

Claims 1 and 3-44 were previously rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Shannon. Applicants respectfully traverse this rejection in view of the amendments to claims 1, 4, 6-9, 23, 25, 27, 29, and 36.

Independent claims 1 and 23 as amended require the use of about 0.1 to about 5 wt% of a film forming compound selected from the group consisting of sulfonated polystyrenes, sulfonated styrene/maleic anhydride copolymers, linear silicone/ethylene oxide copolymers, silicone/acrylate copolymers, and mixtures thereof, while independent claim 36 as amended requires the use of about 0.1 to about 5 wt% of sulfonated styrene/maleic anhydride copolymers.

Applicants respectfully submit that Shannon does not teach or suggest the above polymers, and Shannon does not provide any motivation to one with ordinary skill in the art to modify Shannon in order to use the claimed film forming compounds in the claimed amounts. Such motivation can only be arrived at by using applicants' own disclosure as a template through hindsight, which is improper as discussed above.

Therefore, applicants respectfully assert that the present claims are patentable over Shannon because Shannon does not teach or suggest all the elements of independent claims 1, 23, and 36 as amended. Withdrawal of this rejection is respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to applicants. Accordingly, reconsideration and allowance is respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by applicants' attorneys.

Respectfully submitted,

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